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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/566,629
Filing Date: March 09, 2006
Appellant(s): GELLI ET AL.

Mary Breiner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/18/10 appealing from the Office action mailed 5/19/09.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 44, 45, 51-62, 64, and 91 are pending and are all rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,339,730	RUPPEL et al.	8-1994
WO 99/44814	BIAGIOTTI	9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: Claims 44, 45, 51-62, 64, and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biagiotti(WO 99/44814) in view of Ruppel et al.(U.S. Patent 5,339,730).

Biagiotti discloses forming an embossed laminate by making protuberances on a first web which form a background pattern, making second protuberances on the first web which have greater height and less density than the first pattern(Figure 7), applying glue to the second protuberances, and joining it to a second web.(Figure 6) Biagiotti discloses coloring can be applied by coloring the adhesive.(Pg. 5, ll. 30-31)The reference does not disclose application of any colored pattern to the first set of protuberances. Ruppel et al. discloses embossing a pattern and then printing on the protuberances formed by embossing so that the ink pattern is on the interior of the laminate instead of coloring the adhesive since this allows more choice in the ink

used(Col. 1, ll. 22-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to print on one of the sets of the protuberances since Ruppel discloses this would allow the ink pattern to be between the layers of the laminate and since this would allow more choice in the type of ink used.(Col. 1, ll. 22-33) While Ruppel et al. discloses the printing occurs on the web to which glue is not subsequently applied, it would have been obvious to apply the ink to the protuberances on either of the webs since there are only two choices as to the web to which the ink is applied so it would have been obvious to try either depending on which pattern was desired to have ink and since there is no suggestion in Ruppel et al. that the ink could not applied to the protuberances on the same web to which the glue is later applied.

Regarding claim 45, Biagiotti discloses a pressure roll(311) and an embossing roll(309) and the adhesive is applied to the embossments while the web is still on the embossing roll.(Figure 6)

Regarding claims 51, 56, and 91, Biagiotti discloses the background embossing has a density of 10-100 per square centimeter.(Pg. 15, ll. 27-28)

Regarding claims 52 and 57, one in the art would appreciate that the percent of the surface covered by background embossing is within the purview of one skilled in the art. Additionally, Figure 6A shows the embossing wheel and the embossments appear to be spaced one embossment apart. Extrapolating this to all directions, the embossments would cover 1 in 9 spaces or less than 15%.

Regarding claims 53, 54, and 91, Ruppel et al. discloses it is known to color the glue.(Col. 1, ll. 22-25) It would have been obvious to one of ordinary skill in the art at

the time the invention was made to color the glue and to make it a different color from the printed pattern since two colors form a more decorative and pleasing pattern than a monochromatic color scheme.

Regarding claim 58, Figure 7 of Biagiotti shows one of the second embossments per at least 6 of the first. Extrapolating that in each direction yields one of the second embossments per 36 of the first, leading to less than 3 of the second embossments per centimeter even for 100 per cm of the first.

Regarding claims 61, 62, and 64, one in the art would appreciate that the pattern for the printing could be any conventional type of pattern and would have been well within the purview of choice of one skilled in the art.

(10) Response to Argument

Regarding appellant's argument that the combination of Biagiotti and Ruppel et al. would not result in the printing and gluing being applied to the same ply, there are only two choices for which ply the adhesive is applied to. One in the art would appreciate that the glue could be applied to either ply since there are only two choices. Additionally, it is noted that the claims do not actually require the adhesive to be applied directly to the web containing the printing from the glue applicator. If the webs are tip to tip, the adhesive is applied to the protuberances on the printed web either by direct contact with a glue applicator or by contact with adhesive applied to the tips of the non-printed web.

Regarding appellant's argument that neither of the references discloses printed or glued protrusions having the same density, Biagiotti discloses different size

protrusions. Since the glue is colored in Biagiotti, the different size protrusions do not have different materials applied. Ruppel et al. discloses applying printing and glue to different protrusions, Though it discloses applying the ink to a first set and the glue to a second set.(Figure 2) Since the background embossing occurs first in Biagiotti, one in the art would appreciate it would have the ink applied to it. Additionally, with only two pattern choices, one in the art would appreciate the ink would be applied to one pattern and the glue to the other and there are only two options, either the ink is applied to the background and the glue to the less dense pattern or the ink is applied to the less dense pattern and the glue to the background pattern. It is noted however, that application of the glue to the background pattern may result in a substantial portion of the web being covered with glue, and this area would therefore be unable to absorb fluids, resulting in a decrease in absorbency for the web, which is contrary to the normal desire for toilet tissue and paper towels, which is an increase in absorbency.

Regarding appellant's argument that there is no reason to modify Ruppel such that printing and gluing is performed on the same ply, examiner is not modifying Ruppel et al., but rather modifying Biagiotti. Nonetheless, the standard for obviousness is not only the teaching of the reference, but what one of ordinary skill could glean from the reference as well as the knowledge of one of ordinary skill. When there are only a finite number of predictable solutions, it would have been obvious to one of ordinary skill in the art to try the different solutions as suggested by KSR.

Regarding appellant's argument that one in the art would not have any reason to consider Ruppel to obtain useful teaching, Biagiotti states the glue is colored. Ruppel et

al. specifically states this restricts the choice of glues.(Col. 1, ll. 33-34) The standard is not whether the primary reference suggests the combination as most references do not disclose how they are deficient, but whether the combination is suggested by one of the references, or by the other rationales stated in KSR, such as something being obvious to try since there are only a finite number of predictable solutions.

In response to appellant's argument that Ruppel addresses problems different from those addressed by the claimed method and that the claims do not require synchronizing printing and embossing, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Regarding appellant's argument that Ruppel wants to provide an improvement on a conventional printing process where the printing is on the outside, the reference also discloses that its process is intended to be an improvement on a process where the glue is colored.(Col. 1, ll. 33-34)

Regarding appellant's argument that Ruppel does not teach two different embossings on one ply, Biagiotti does.

Regarding appellant's argument that if printing and embossing occur on the same ply, degradation is a consequence which examiner's rejection does not correct, whether the amount of degradation is acceptable is dependent on the desires of the manufacturer. It is noted that appellant prints on the ply after embossing which appellant points out Ruppel indicates causes degradation of the image, and clearly the

degradation is acceptable in that instance. Appellant specifically states on page 12 of the arguments dated 9/21/09 that printing and then embossing can avoid degradation but does not state why the degradation does not occur.

Regarding appellant's argument that Ruppel teaches that when printing and embossing occur on the same ply, degradation occurs, Ruppel teaches that when embossing of a design occurs AFTER printing of the design (presumably at a different station since Ruppel also references synchronizing printing and embossing), degradation occurs. This is not the same thing.

Regarding appellant's argument that Ruppel wants to synchronize embossing and printing, examiner is not taking the entire device of Ruppel and placing it in the device of Biagiotti. Rather, examiner is taking the concept of printing on the interior of the ply and applying it to Biagiotti. Additionally, when using the interior printing of Ruppel in Biagiotti, since the printing is applied to the embossments, one in the art would have appreciated it would have been applied while the ply was still on the embossing roll, effectively synchronizing the printing and embossing.

Regarding appellant's argument that one would not have modified Ruppel to print and emboss on the same ply, Ruppel already teaches printing and embossing on the same ply. The reference does not print and emboss on separate plies to fix synchronization and avoid degradation, it prints on the ply still on the embossing roll to synchronize and avoid degradation, which can be done in Biagiotti.

Regarding appellant's argument that appellant's claim results in a textile effect, the claims do not require such.

Regarding appellant's argument that appellant's background pattern is a micro-embossing pattern, the pattern of Biagiotti appears to be a micro-embossing pattern as well. (Figure 10, 201p)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

BJM

/B. J. M./

Examiner, Art Unit 1746

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